

REMARKS/ARGUMENTS

Applicants gratefully acknowledge the withdrawal of the rejection based upon 35 U.S.C. § 112, Second Paragraph and the withdrawal of the finality of the previous Office Action.

Entry of the foregoing amendments, and reconsideration of the subject application in view of the following remarks is respectfully requested.

Claims 1-17, 19-24 and 33 remain pending in this application. Applicants propose amending claim 17. Applicants respectfully submit that the amendment to the claim places it in condition for allowance or in a better form for consideration on appeal. No new matter is added by the amendment.

As the present response addresses all outstanding issues, Applicants once again respectfully request that the Examiner declare an Interference consistent with their Second Request for an Interference pursuant to 37 C.F.R. § 1.607 filed on November 4, 2003.

I. Claim Rejection under 35 U.S.C. § 112, First Paragraph

Claims 17 and 19-24 remain rejected under 35 U.S.C. § 112, first paragraph as allegedly containing new matter. In particular, the Patent Office alleges that Applicants identification of support for the instant claims does not provide full support for "(i) the formula of the organopolysiloxane and (ii) the range of peroxide, respectively, of claim 17." Office Action, page 2. Each of these issues is discussed separately below.

A. The claimed peroxide range is expressly disclosed

In response to the Examiner's comments in the Office Action, Applicants clarify their arguments as follows and provide the attached Appendix A to support their assertion that the claimed peroxide range ("from about 0.1% to about 5% by weight of the total composition of a curing agent") are disclosed in the specification. As shown in Exhibit A, a composition of 15% silicone polymer and 0.75% curing agent (as provided by the embodiment described in the specification on page 2, lines 19-28) is the same as a composition of 100 weight parts silicone polymer and *5 weight parts curing agent*, or in other words, the upper value of the claimed range. Likewise, a composition of 50% silicone polymer and 0.1% curing agent is the same as a composition of 100 weight parts silicone polymer and 0.2 weight parts curing agent. The lower range is supported when one takes into consideration that 100 weight parts of silicone polymer are also disclosed, see Example 1, page 12, lines 9-14, because 0.1 % of 100 weight parts is the same as 0.1 weight parts.

This is also consistent with the examples which provide as follows. Example 1 of the specification describes the preparation of the claimed product using "1.25 parts 2,5-dimethyl(t-butylperoxy)hexane peroxide," which is well within the claimed range. See page 12, lines 22-23. Likewise, Example 2 of the specification describes the preparation of the claimed product using "1.4 parts 2,4-dichlorobenzoyl peroxide," which is also well within the claimed range. See page 15, lines 2-3.

It is well established that "[t]he fundamental factual inquiry [for determining compliance with the written description requirement] is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." See MPEP

§ 2163.I.B. (Eighth Ed. Rev. 2 2004) (citing *Vas-Cath, Inc.*, 935 F.2d 1555, 1563-64, 19 USPQ2d at 1117 (Fed. Cir. 1991). In view of the foregoing, it is apparent that the specification conveys that Applicants were in possession of the peroxide ranges recited in claim 17.

B. The formula of organopolysiloxane

Although Applicants maintain that the organopolysiloxane formula recited in claim 17, namely $R_aSiO_{(4-a)/2}$ in which R is selected from substituted and unsubstituted monovalent hydrocarbon groups and a has a value from 1.95 to 2.05 is implicitly and inherently disclosed in the original specification for at least the reasons previously provided, Applicants nonetheless amend the claim to further the prosecution of this matter. In particular, Applicants have amended the claim to recite that a has a value of 2. Applicants believe that the Examiner has indicated that there is support for this amount. Accordingly, Applicants respectfully submit that the amendment obviates the basis for rejection.

In view of at least the foregoing, Applicants respectfully request that the Examiner withdraw the rejection as to claims 17 and 19-24 under 35 U.S.C. § 112, first paragraph.

II. Claim Rejection under 35 U.S.C. § 102(e)

The Patent Office rejects claims 1-6, 8-13, 15-24 and 33 as allegedly anticipated by Matsushita et al. (U.S. Patent No. 5,824,729). As previously noted, Applicants previously submitted a Request for an Interference Pursuant to 37 C.F.R. § 607 accompanied by an affidavit antedating Matsushita as a reference, in accordance with

37 C.F.R. § 608. The interference request has not yet been considered by the Patent Office. A Second Request for an Interference Pursuant to 37 C.F.R. § 607 was also submitted with Applicants' previous response consistent with the previously presented claim amendments. This interference request has also not yet been considered. Although Applicants urge otherwise, the Examiner currently indicates she will not consider Applicants' Request for an Interference until all other issues relating to patentability of this invention have been resolved. When Applicant's request is considered, the Rule 608 affidavit will remove Matsushita as a reference.

III. Claim Rejection under 35 U.S.C. § 103(a)

A. Matsushita et al.

Claims 7, 12, and 14 are rejected as obvious over Matsushita et al. As discussed above and in Applicants' previous response, Applicants respectfully traverse the rejection because Matsushita is not a proper reference and should be removed upon the Patent Office's consideration of Applicants' Request for an Interference and Rule 608 affidavit.

B. Dams in view of Milbert

Claims 1-17 and 19-24 and 33 are rejected as obvious over Dams (U.S. Patent No. 4,355,129) in view of Milbert (U.S. Patent No. 3,821,140). Applicants respectfully traverse the rejection for the following reasons.

In the Office Action, the Examiner responds to Applicants' argument that Dams and Milbert are not properly combinable by asserting that the references are analogous because both teach silicone compositions being used as insulating material. Office

Serial No. 09/000,824
Attorney Docket No. 41980.002004

Action, page 4. However, to establish a *prima facie* case of obviousness, there must be a suggestion or motivation to combine the references. Thus, even if the references are analogous, that alone does not render the references properly combinable. Further, the mere fact that references can be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination.* See MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)); see also MPEP 2144.08.II.A (stating "it is essential the Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings") (citing *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996). [emphasis added]

Here, the prior art does not suggest the desirability of the combination. In fact, both Dams and Milbert suggest quite the contrary. For example, Dams states that "the compositions of this invention are particularly suitable for use in the fabrication of articles which may be subjected to the effect of electrical surface discharges and where resistance to change in the electrical and physical properties is desired." Col. 3, ln. 38-42. Likewise, Milbert states that the elastomers "have good mechanical properties and are fire resistant." Col. 4, ln. 1-4. Thus, there was no expectation of any advantage in combining the references. Therefore, a person skilled in the art would not be motivated to modify the compositions of either reference to incorporate components of the other. Accordingly, a *prima facie* case of obviousness is not established.

Further, as previously argued by Applicants, even when combined the references are deficient for failing to disclose the claimed range of the coupling agent (e.g., from about 0.01% to about 1% by weight of the total composition of a coupling agent). The

Examiner responds to this argument by asserting that the amount of the coupling agent could be determined through routine experimentation. However, Applicants respectfully submit that the amounts could not be determined through undue experimentation. In particular, given the unpredictability of the technology there can be no reasonable expectation of success (*See MPEP § 2143*) where one merely picks and chooses from the multitude of possibilities and combinations. Although the Examiner cites U.S. Patent No. 5,583,172 to Imahashi et al. as evidence of the use of coupling agents at the time of the invention, Imahashi merely refers to the use of coupling agents as a surface treatment for metal hydroxide and flame retardant aid before their incorporation into synthetic resins. Moreover, the amount of coupling agent disclosed in the reference is 0.1 to 10 parts by weight relative to 100 parts by weight *of the flame retardant*. [emphasis added] Thus, the disclosure provides no guidance regarding the amount of coupling agent used in the synthetic resin it describes, let alone the compositions of the present invention. Additionally, the Examiner has not responded to Applicants argument pointing out that there is no evidence that the amount of the coupling agent was recognized in the prior art to be a results-effective variable. See MPEP 2144.05.II.B. Accordingly, even when combined the references are deficient and thus a *prima facie* case of obviousness is not established.

Finally, even if a *prima facie* case of obviousness was established, it would be rebutted by the unexpected results achieved by the claimed invention. In response to the Examiner's comments that Applicants' statement in the specification that all of the products prepared showed superior physical properties in the specification does not meet the requirement for overcoming the rejection over the cited reference, Applicants

Serial No. 09/000,824
Attorney Docket No. 41980.002004

further clarify their argument. In particular, Applicants respectfully direct the Examiner's attention to Tables I, II, III, IV and V of Milbert and Table I of the present specification at page 13. A comparison of the values from the tables shows that the present invention achieves a Shore A Hardness of 70 as compared to the prior art which achieves considerably lower values. Moreover, the specification points out that "at higher silane coupling agent concentrations (VTES), and higher ATH loading the product showed increased times to failure in tracking and erosion testing." Page 13, line 22-page 14, line 2. See also, Table II on page 14.

In view of at least the foregoing, Applicants submit that claims 1-17, 19-24 and 33 are in condition for allowance and reiterate their request that the Patent Office withdraw its rejection and declare an interference with Matsushita and U.S. Patent No. 6,090,879.

IV. Conclusion

Applicants respectfully request that the Examiner withdraw the outstanding rejections and declare an interference as previously requested. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below to conduct an interview in an effort to expedite prosecution in connection with the present application.

Serial No. 09/000,824
Attorney Docket No. 41980.002004

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-0206.

Respectfully submitted,

Dated: April 1, 2005 By: Scott Yamell

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